

Docket No.: 408-001



AT ZW
D/E

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Enrique Molina)
Serial No.: 09/995,486) Art Unit 3635
Filed: November 28, 2001) Examiner:
For: BUILDING CONSTRUCTION SYSTEM) Jeanette E. Chapman

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION UNDER 37 C.F.R. § 1.181 TO
VACATE A FINAL REJECTION AS PREMATURE**

Applicant hereby requests the Director to vacate the FINAL status of the January 26, 2006 office action in which a new examiner a) cited a new reference not necessitated by Applicant's June 28, 2005 amendment following a previous examiner's reopening of prosecution on March 28, 2005; b) rejected the remaining amended claims based on the new reference; and c) made the action FINAL. Applicant's amendment presented no new issues in his June 28, 2005 amended claims, which more particularly point out and distinctly claim Applicant's invention under 35 U.S.C. 112.

In a March 20, 2006 interview granted Applicant's attorney, the new examiner agreed that citing a new reference had to be in response to the raising of a new issue before an office action could be made FINAL. The arguments herein were presented in Applicant's amendment filed March 21, 2006 and in his request to allow proposed amendments to the claims in view of the examiner's comments regarding the newly cited Hibbard reference.

In a March 29, 2006 advisory action received March 31, 2006, the examiner states that Applicant's amendment fails to place this application in condition for allowance; that the amendment raises new issues that would require further consideration and/or search; that the proposed amendments do not place the application in better form for appeal and thus will not be entered for purposes of appeal; and that the request for reconsideration does not place the application in condition for allowance because Applicant arguments were not persuasive.

Applicant respectfully disagrees with the examiner's conclusions based on her analysis, and petitions the Director to invoke his authority to vacate the examiner's March 29, 2006 refusal to enter Applicant's amendments to his claims that are in direct response to her application of Hibbard to Applicant's claimed invention, and places them in a better form for appeal by materially reducing or simplifying the issues for appeal.

ARGUMENT

Hibbard Should Have Been Cited and Applied Before Applicant's June 28, 2005 Amendment

It is respectfully submitted that Applicant's June 28, 2005 amendment did not raise any new issues not already before the PTO and considered by the previous examiner. So no new search was required nor was the citing of Hibbard required. In fact, Applicant's amendment narrowed the issues and presented nothing new that has not been before presented.

Before June 28, 2005 amendment, Applicant claim set forth "reinforcement rod suspending means for freely positioning and retaining freely disposed, horizontally extending reinforcement rods, said rod suspending means including a plurality of grid elements each having a plurality of elongate elements that extend vertically along and are substantially parallel to the vertically disposed molding surfaces with each element having a plurality of tie members fixedly connected to the vertically disposed elongate elements, said tie members extend substantially perpendicular to the molding surfaces to define a plurality of vertically spaced locations of support for the horizontally disposed reinforcement rods."

Claim 2 stated that the "rod suspending means" of claim 1 "includes grid means that extends vertically along the vertically disposed molding surfaces."

Claim 5 stated that "said plurality of vertically disposed grid elements are spaced horizontally with respect to each said opposed spaced molding surfaces, said reinforcement rods are horizontally disposed across said plurality of tie members, and said reinforcement rods extend substantially parallel to the molding surfaces and are laterally spaced with respect to each other between said molding surfaces."

Before Applicant's amendment, claim 1 included "a plurality of grid elements each having a plurality of elongate elements *that extend vertically along* and are substantially parallel to the vertically disposed molding surfaces." The examiner admits that "Hibbard lacks the means for

attaching the grid means [really Hibbard's ladders] to the opposed panels 60/62 to retain the rods in place at a plurality of vertically spaced locations while the hardenable material is poured into the cavity and allowed to harden." (See January 26, 2006 Office Action, lines 8 to 10.) So the examiner recognizes that Applicant's grid means are attached to the molding surface and Hibbard's ladders are not attached. Yet she equates Applicant's ladders 18/28/24/26 to grid means and his cross members 28 to "reinforcement rods." So she equates Hibbard single members 28 to two of Applicant's different distinctly claimed members – the tie member that supports reinforcing rods and the reinforcing rods themselves.

If Hibbard applies to Applicant's claims now, it should have been cited and applied before Applicant's June 28, 2005 amendment because the same issues existed at the time. Then Applicant would have had the opportunity to fully distinguish all of his claims to eliminate the examiner's argument that Hibbard cross member 28 can, at the same time, fulfill more than one limitation in Applicant's claims.

To reduce the issues regarding the subject matter of Claim 1, Applicant deleted the language "rod suspending means including a plurality of grid elements" and replaced it with "a plurality of grid means" and clarified its relationship with the freely disposed, horizontally extending reinforcement rods now set forth in the preamble of Claim 1. So the language of subparagraphs d) and e) now read: "a plurality of grid means suspended along the vertically disposed molding surfaces in said mold cavity for contiguously supporting said horizontally extending reinforcement rods so as to be freely disposed at a plurality of vertically spaced locations within said mold cavity without connection to said grid means."

Hibbard does not disclose any structure "suspended along the vertically disposed molding surface" for any purpose, let alone "a plurality of grid means ... for contiguously supporting said horizontally extending reinforcement rods so as to be freely disposed at a plurality of vertically spaced locations within said mold cavity without connection to said grid means." ***So Applicant's Claim 1, 3, 4, and 5 amendments did not necessitate the citing of Hibbard that connects his horizontal ladders to cross members 28 so that the horizontal ladders are not freely disposed on members 28.***

Before his June 28, 2005 amendment, Applicant's claim 6 set forth "reinforcement rod

suspending means for freely positioning and retaining freely disposed, horizontally extending reinforcement rods at a preselected horizontal location spaced inwardly from each said opposed molding surface within said mold cavity.” Applicant substituted “a plurality of grid means” for “reinforcement rod suspending means” and further characterized them as “suspended along the vertically disposed molding surfaces in said mold cavity.” So subparagraph d) of Claim 6 now reads: “a plurality of grid means suspended along the vertically disposed molding surfaces in said mold cavity for freely positioning and retaining freely disposed, horizontally extending reinforcement rods at a preselected horizontal location spaced inwardly from each said opposed molding surface within said mold cavity.”

Again, Hibbard does not disclose “a plurality of grid means suspended along the vertically disposed molding surfaces in said mold cavity for freely positioning and retaining freely disposed, horizontally extending reinforcement rods at a preselected horizontal location spaced inwardly from each said opposed molding surface within said mold cavity.” ***So Applicant’s Claim 6 amendment did not necessitate the citing and applying of Hibbard to support a rejection under § 103.***

The “rod locating means” of Claim 7 was not amended. Hibbard shows no rod locating means for the horizontally disposed reinforcement rod 70 that is disposed across bottom trusses 64 without having any “rod locating means” associated with it. ***So Applicant’s Claim 7 amendment did not necessitate the citing and applying of Hibbard to support a rejection under § 103.***

Regarding new Claim 48 submitted June 28, 2005, Applicant sets forth “a plurality of grid means suspended within said mold cavity for contiguously supporting said horizontally extending reinforcement rods so as to be freely contiguously disposed on said grid means.” As shown above, Hibbard does not disclose such a “plurality of grid means suspended within” the mold cavity to achieve the stated function of “contiguously supporting said horizontally extending reinforcement rods so as to be freely contiguously disposed on said grid means” at a “plurality of horizontal locations vertically spaced along and between said opposed wall surfaces.” Moreover, Hibbard does not disclose “means for removably attaching said grid means to said opposed wall molding panels at laterally spaced horizontal distances with respect to each other to retain said reinforcement rods in place while hardenable material is being poured into said wall mold cavity and allowed to harden.” ***So Applicant’s New Claim 48 did not necessitate the citing and applying of Hibbard to support a***

rejection under § 103.

Regarding new Claims 49 and 50, Applicant specifies each grid means as including “a plurality of elongate elements for extending vertically in a direction substantially parallel to the molding surfaces and a plurality of horizontal tie members fixedly connected to and substantially perpendicular to said elongate elements” and “being vertically spaced with respect to each other to provide contiguous support for said reinforcement rods at said vertically spaced horizontal locations” so that the reinforcement rods are “freely contiguously resting on said horizontal tie members at laterally spaced distances inwardly from each said opposed molding surface.” Hibbard does not disclose Applicant’s grid means let alone the details of his grid means. *So Applicant’s New Claims 49 and 50 did not necessitate citing and applying of Hibbard to support a rejection under §103.*

After Applicant’s June 28, 2005 amendment, the examiner simply looked at Hibbard’s drawings and likened his structure to “a plurality of grid means 18/28/24/26 suspended along the vertically disposed molding surfaces in the cavity.” And she states that each Hibbard vertical ladder 18 “is a rigid structure composed of a pair of parallel, vertical members 24,26 extending the full vertical height of the wall 10. A plurality of rigid cross members 28 extend between the vertical members 24,26 and are spaced apart along the vertical height of the vertical ladder 18.” (See Hibbard, col. 4, ls. 4-9.) So the examiner simply looked at structure without considering the particular function of that structure which does not perform Applicant’s particular function to achieve specified results. In other words, Hibbard “18/28/24/26” elements are *not* “grid means” as alleged but vertical ladders fixedly held between sections of a “rigid insulation core through which the vertical ladder structures extend transversely.”

In any event the new examiner inappropriately equates Hibbard’s “rigid cross members 28” to Applicant’s horizontally disposed reinforcement rods. And then later says that cross members 28 support reinforcement rods instead of being a reinforcement rod as earlier alleged.

Hibbard states that at “each interface between the panels 20,21 there is a transversely positioned vertical ladder 18 which extends through the junction 22 between individual insulation panels 20,21.” (See col. 3, ls. 65-68.) The ladder structures 18/28/24/26 are **NOT** “grid means” “suspended along the vertically disposed molding surfaces in the cavity.” Ladder structures 18/28/24/26 are placed one at a time between each panel 20,21, and are not suspended from molding

forms 60/62 as Applicant claims. In short, Hibbard must first position three parallel panels 60, 62, and 20 before placing his ladders for connection to the three parallel panels with horizontal trusses 64. A very complex process.

Hibbard should have been cited earlier to allege his ladder structures to be “grid means” before the June 28, 2005 amendment. So the citing and applying of Hibbard was not necessitated by Applicant’s amendment. For the Hibbard ladder is NOT Applicant’s claimed “grid means” suspended from a vertically disposed molding surface as alleged. But the Hibbard structures hold an insulation core in place between opposed molding surfaces. Something that is not possible in Applicant’s structure and is not claimed.

Applicant’s amendment cannot justify citing Hibbard, which has no structure usable in Applicant’s invention. Since the citation of Hibbard to support new grounds of rejection was not necessitated by the presentation of new issues caused by Applicant’s amendment, the FINAL status of the Office Action is respectfully deemed premature and improper.

Overlooked Claim 17 In Applicant’s June 28, 2005 Amendment Not Considered

Applicant submitted amended Claim 17 in his June 28, 2005 amendment as follows:
17 (withdrawn) (currently amended): ~~A device~~ An assembly as defined in claim 9 48 wherein
 ~~said rod suspending means retains reinforcement rod means that includes at least two~~
~~elongate rod members~~ reinforcement rods are each freely positioned horizontally at a spaced inward
distance from the opposed molding surfaces and at a spaced outward distance from a centerline
located between said opposed molding surfaces.

The new examiner overlooked this earlier claim now dependent on new Claim 48 and Claim 17 should have been acted on, and Applicant should have been advised as to its status regarding Hibbard and Wepf. At the least, Applicant should have been advised at the time the new Hibbard reference was cited that Claim 17 was reinstated as being dependent on new Claim 48 rather than on withdrawn Claim 9.

In any event, the Director is respectfully requested to vacate the FINAL status of the January 26, 2006 office action in which the new examiner failed to reinstate Claim 17 and act on it as depending from new Claim 48.

PTO Fails To Address Applicant’s Amendment To Overcome § 112 Objection To Claim 5

In response to the PTO objection to Claim 5 “because of the following informalities: Lines 4-5 have no clear meaning,” Applicant amended Claim 5 as follows:

5 (currently amended): ~~A forming~~ An assembly as defined in claim 1 wherein said plurality of ~~vertically disposed grid elements are~~ grid means is laterally spaced horizontally with respect to each other along said opposed ~~spaced~~ molding surfaces, said reinforcement rods are horizontally freely disposed across said plurality of ~~tie members~~ grid means, and

said reinforcement rods extend substantially parallel to the molding surfaces and are laterally spaced with respect to each other between said molding surfaces.

While statutory authority for this objection is not expressly cited, it is necessarily authorized under 35 U.S.C. § 112. FINAL status should not be applied to this first objection to amended Claim 5. For Applicant should have the right to amend Claim 5 to overcome this objection. To overcome the objection, on March 21, 2006 Applicant proposed the following amendments:

5 (currently amended): An assembly as defined in claim 1 wherein said plurality of grid means is laterally spaced horizontally with respect to each other along said opposed molding surfaces,

said reinforcement rods are horizontally freely disposed contiguously on and transversely across said plurality of grid means, and

said reinforcement rods ~~extend substantially parallel to the molding surfaces and~~ are laterally spaced with respect to each other between said molding surfaces.

The proposed amendments were discussed at the March 20, 2006 interview for which the Interview Summary states regarding its substance: “Applicant proposed : A) amending claim 5 to overcome the objection to claim 5: B) Amending claim 1 to add in part of the limitations of claim 5.” The examiner did not state one way or another if Applicant’s proposed amendment would overcome her objection to Claim 5 and did not make any suggestions as to how Applicant could overcome the rejection. So Applicant was left in a quandary as to how the examiner regarded the specifically proposed language.

Applicant filed his proposed amendments on March 21, 2006 and stated regarding Claim 5:

Before the amendment, lines 4-5 read: “said reinforcement rods are horizontally

disposed across said plurality of tie members,” yet the language was not objected to under 35 U.S.C. § 112. Now, however, with only the addition of “freely” before “disposed” and “grid means” replacing “tie elements,” the new examiner objects to the amendment under 35 U.S.C. § 112. Thus, another reason exists for the Finality of the new office action to be premature.

And after quoting Claim 5 with its proposed amendments, Applicant then stated:

So regarding to claim 5, lines 4-5 now read: “said reinforcement rods are horizontally freely disposed contiguously on and transversely across said plurality of grid means,” and hopefully the current amendment overcomes the examiner’s new objection under 35 U.S.C. § 112.

Moreover, the deletion of the phrase, “extend substantially parallel to the molding surfaces and,” and its proposed insertion into claim 1 is necessitated by the examiner’s erroneous reading of Hibbard cross members 28 as equivalent to Applicant’s horizontally disposed reinforcement rods 24 contiguously on and transversely across Applicant’s grid means (grid elements) 25/26/27/28.

However, the March 29, 2006 Office Action does not address the proposed amendment to Claim 5. The examiner simply checks the boxes on the form that state that the proposed amendments “raise new issues that would require further consideration” and “are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.” Applicant respectfully submits that the objection to Claim 5 under § 112, second paragraph, without allowing Applicant to amend his claim language by right makes the FINAL status of the outstanding January 26, 2006 office action premature and requests that the FINAL status be vacated.

Applicant’s proposed amendments should be entered because they reduce and simplify the issues for appeal.

Reinstate Claims 9-10, 14-16, 28-29, and 31-35

The reasons given here for reinstatement of Claims 9-10, 14-16, 28-29, and 31-35 were presented in Applicant’s March 21, 2006 amendment and response to the outstanding January 26, 2006 Office Action. Such reinstatement is in the interest of expediting prosecution of Applicant’s claims that have been pending more than four (4) years, and in the interest of fair play and justice. However, the PTO did not address Applicant’s request in its March 29, 2006 Advisory Action. For this reason, Applicant requests the Director to exercise his supervisory authority and address this reinstatement question and allow reinstatement of these claims for the reasons given.

Independent claim 9, as amended, is directed to a “grid device for horizontally disposing reinforcement rods in a poured-in-place wall mold cavity defined by opposed molding surfaces of opposed vertically disposed wall molding panels,” and is currently amended to include the limitations of former cancelled claim 12 and of currently amended withdrawn claim 10. Claims 14-16 depend from independent claim 9 and further limit the claimed grid device to necessarily be part of Applicant’s invention of claims 1, 3-7, 17, and 48-50 that require use of the claimed grid device of claims 9 and 14-16. The examiner need not conduct a further search for Applicant’s claimed grid device that is useful for no other purpose than to make the assembly of claims 1, 3-7, 17, and 48-50.

The original requirement for restriction of Group II claims 9-16 was based on being drawn to an invention classified in class 52, subclass 677 while the Group I claims 1-8 was based on being drawn to an invention classified in class 249, subclass 40. The former examiner then proceeded to make the restriction of the invention on the basis of a species restriction without a generic claim in citing MPEP Sections 806.04(b) and 806.04(h).

MPEP Section 806.04 reads:

Where an application includes claims directed to different embodiments or species that could fall within the scope of a generic claim, restriction between the species may be proper if the species are independent or distinct. However, 37 CFR 1.141 provides that an allowable generic claim may link a reasonable number of species embraced thereby. The practice is set forth in 37 CFR 1.146.

MPEP Section 806.04(d) defines a generic claim as follows.

In an application presenting three species illustrated, for example, in Figures 1, 2, and 3, respectively, a generic claim should read on each of these views; but the fact that a claim does so read is not conclusive that it is generic. It may define only an element or subcombination common to the several species.

In general, a generic claim should require no material element additional to those required by the species claims, and each of the species claims must require all the limitations of the generic claim.

MPEP Section 806.04(h) states when multiple species must be patentably distinct.

In making a requirement for restriction in an application claiming plural species, the examiner should group together species considered clearly unpatentable over each other.

Applicant’s application illustrates the claimed assembly and grid device in his Figures 3 and

4 that do not show more than one species of the grid device that is necessarily used in the claimed assembly. Applicant does not understand how Groups I and II inventions are “mutually exclusive species in an intermediate final product” when the assembly is the final product and the grid device is an essential part of the claimed final product. To be a complete search, both classes, namely, class 52, subclass 677 and class 249, subclass 40, should have been searched for the claimed Group I invention since both sets of claims relate to a poured-in-place wall structure mold cavity.

In view of the foregoing, claims 9, 10, and 14-16, as amended, should be reinstated in the application and deemed allowable for the reasons stated in response to the rejection of assembly claims over Hibbard in view of Wepf.

Claims 28, 29 and 31-35 are directed to a “method for producing a vertically disposed poured-in-place wall structure having horizontally disposed reinforcement rods” that provides wall molding means that form a mold cavity, and “a plurality of grid means for extending vertically along the vertically disposed molding surfaces and being sufficiently rigid for freely positioning and retaining said reinforcement rods horizontally along said first molding surface at a preselected horizontal location laterally spaced from said first molding surface and at preselected vertical locations spaced along said first molding surface.”

The former examiner said that “the process for using the product [assembly] as claimed can be practiced with another materially different product” *or* “the product as claimed can be used in a materially different process of using the product” and cited MPEP Section 806.05(h). The examiner then states that in “the instant case a forming method can be accomplished by chiseling rough concrete.” Applicant does not understand how the method of using the claimed assembly can be “practiced with another materially different” assembly. For the claimed process specifically provides the product that is set forth in the Group I assembly claims. So the process cannot be practiced “with another materially different product” as alleged.

Moreover, that the former examiner’s suggested a “forming method” of “chiseling rough concrete” is incomprehensible to Applicant who does not understand how anyone can effect “chiseling rough concrete” with the claimed assembly. Therefore, Applicant respectfully requests that method claims 28, 29 and 31-35, as amended, be reinstated in the application and deemed allowable for the reasons stated in response to the rejection of assembly claims over Hibbard in view

of Wepf.

Summary and Conclusions

In summary, the FINAL status of the January 26, 2006 Office Action is premature because of the following reasons:

The Hibbard reference should have been cited and applied before Applicant's June 28, 2005 amendment that did not change the issues before the PTO.

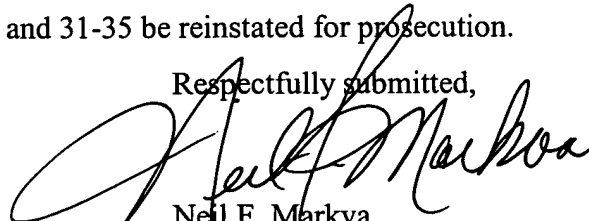
The PTO overlooked amended Claim 17 in Applicant's June 28, 2005 response and it was not considered by the examiner before premature FINAL rejection of the applicant's claims.

The PTO failed to address Applicant's amendment to overcome its first time § 112 objection to Claim 5 and made premature FINAL rejection of Applicant's claim.

The PTO failed to consider Applicant's request to reinstate Claims 9-10, 14-16, 28-29, and 31-35 in his June 28, 2005 and March 21, 2006 responsive amendments.

For the foregoing reasons, Applicant respectfully requests that a) the FINAL status of the January 26, 2006 be vacated; b) amended Claim 17 be reinstated as dependent from Claim 48; c) Applicant's March 21, 2006 amendment be entered to place the case in better condition for appeal; and d) Applicant's Claims 9-10, 14-16, 28-29, and 31-35 be reinstated for prosecution.

Respectfully submitted,



Neil F. Markva
Attorney for Applicant

8322-A Traford Lane
Springfield, Virginia 22152
(703) 644-5000